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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,388	09/26/2003	Beatrice Toumi	05725.1243-00000	2739
22852	7590	11/25/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER MERCIER, MELISSA S	
			ART UNIT	PAPER NUMBER
			1615	
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			11/25/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,388

Applicant(s)

TOUMI ET AL.

Examiner

MELISSA S. MERCIER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4-17-08, 8-8-08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 26-30, 33-39, 41-44, 70, 77-101, 110 and 114-140 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims **withdrawn** from consideration are 16,17,19-25,31,32,40,45-69,71-76,102-109 and 111-113.

DETAILED ACTION

Summary

Receipt of Applicants Remarks and Amended claims filed on April 17, 2008 and August 8, 2008 is acknowledged. Claims 1-140 remain pending in this application. Claims 16-17, 19-25, 31-32, 40, 45-69, 71-76, and 103-109, and 111-113 remain withdrawn from consideration as reading on non-elected species. Therefore, claims 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, and 114-140 remain under examination in this application. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Receipt of the Terminal Disclaimer filed on August 8, 2008 is acknowledged.

Specification

The specification on page 1, paragraph 1, recites "This application claims priority under 35 USC, 119 of Application No. 0.211949, filed September 26, 2002, Application No. 0216437, filed December 20, 2002, and Application No. 0306121, filed on May 21, 2003, in France, all of which are incorporated herein by reference. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the

Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Claim Objections

Claim 102 is objected to because of the following informalities: Applicant has identified the claim as being withdrawn. However, claim 102 is under prosecution to the extent that it reads on the elected species, (i.e. h. alkanes that are liquid at room temp, as recited in claim 110). Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, and 114-140 rejected under 35 U.S.C. 103(a) as being unpatentable over Galleguillos et al. (US Patent 6,410,005).

The claims are drawn to a nail varnish composition comprising a block polymer in a medium comprising an organic solvent. Numerous functional properties are also claimed. Additional independent claims are drawn to a method of applying the composition and kit containing the composition.

Galleguillos discloses AB block copolymer comprising a soft hydrophobic and a hard, hydrophilic blocks with two or more distinct glass transition temperatures, represented by Structures 1 and 2 (column 4, lines 44-65). Galleguillos further discloses the copolymers may be delivered from aqueous or hydro alcoholic solutions, dispersions or emulsions. The copolymers may be water, water-ethanol, or water solvent mixtures by dispersing the copolymer in solvent and adjusting the pH with an organic or inorganic base (column 13, lines 55-62) and incorporated into a nail formulation (column 14, lines 30-32).

Regarding claims 14-15, 18, 29-30, 33, 39, 41, suitable hydrophobic monomer A includes the various (meth)acrylates, (meth)acrylamides expressed in the claims, with preferred species such as n-butyl acrylate, ethyl acrylate and 2-ethylhexyl acrylate which read on the instant low T_g monomeric species (column 7, line 65 to column 9, line 2). Galleguillos's preferred hydrophilic monomer B include ethylenically unsaturated carboxylic acid such as (meth)acrylic acid, along with the disclosed alkyl methacrylates, block having T_g greater than or equal to 40°C (column 10, line 57 to column 11, line 30). Galleguillos also specifically discloses using varying proportion of mixtures of A and B monomers so as to achieve the desired balance of the resultant block polymer properties (column 12, lines 12-15; column 13, lines 1-8).

Regarding claims 26, 70, and 85, also disclosed is a process of polymerizing a polyfunctional monomer X within the scope of the instant intermediate block constituent (column 4, structures 1 and 2) with a first ethylenically unsaturated monomer(s) to form an A block, and subsequently polymerizing a second ethylenically unsaturated

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monomer(s) containing at least one carboxylic acid group with the A block to form a B block, and the resultant block copolymer (column 3, lines 53-60; column 4, lines 18-43; column 5, lines 2-4; column 6, line 27 through column 7, line 57). Thus, a copolymer containing blocks of $-(B)p-X-(B)q-$, and $-(A)n-A-X-A-(A)n-$ is formed, wherein X is a multifunctional monomer that links A and B block. The linkage of X-X reads on the instant intermediate block, wherein X is also a constituent monomer of the A and B blocks in $-(B)p-X-(B)q-$, and $-(A)n-A-X-A-(A)n-$. Absent of specific compositional and architectural details defined for the instant intermediate block, prior art $-B-X-X-A-$ linkages in structures 1 and 2 fall within the scope of the instant intermediate block as both block A and B contains at least one constituent X, as defined in the present claims.

Regarding claims 34-36, 42-44, 99-101, Additionally, the weight percent of each of the monomers in the mixture can vary, depending on the desired properties if the final copolymer product. In one embodiment, 28 wt% to about 60 wt% of monomer A for A block and about 38 wt% to about 60 wt% of monomer B, for B block (column 13, lines 1-8).

Regarding claims 91-96, Galleguillos also teaches an average molecular weight of the resultant block copolymer of up to 1,000,000, having film forming property and water dispensability (column 6, lines 3-5).

Regarding claim 115-117, the solvent system can comprise up to 25% by weight of an organic solvent (column 14, lines 8-10).

Regarding claims 118-128, the formulation may further comprise formulation additives including fragrances, dyes and colorants, plasticizers, emulsifiers, UV

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absorbers, lubricants and penetrates (column 14, lines 20-28). Additional optional resins may also be incorporated (column 18, lines 54-65). Additives can be present in the amount of 0.01-19% of the formulation (column 18, lines 41-43).

Regarding claims 131-140, Galleguillos discloses a cosmetic composition. Depending on the intended use, one of ordinary skill in the art would have been motivated to package a composition in a kit. Kits provide a convenient mechanism to disperse products to consumers, as a kit would provide a convenient mechanism to disperse a cosmetic product to consumers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to package a cosmetic composition, such as the one in the instant application, in a kit. The use of packaging components such as glass and plastic are well known in the art since they do not tend to react with the composition stored inside it.

Galleguillos discloses the method and the selection of various monomers species in formation block copolymer systems having balance of hydrophilic/hydrophobic properties. The selection of hard and soft block components with differences in glass transition temperature is suggested within the scope of the present claims. Accordingly, it would have been obvious to one of ordinary skill in the art would have readily envisaged the selection of the suitable monomers having Tg differences as taught, motivated by the reasonable expectation of success in forming block copolymers with balanced hydrophilic/hydrophobic characteristics. Once the respective monomer block components are suggested with Tg consideration, the determination of their optimum proportions or workable ranges taught within the general disclosures of prior art, would

involve only routine skill in the art. The reference is silent regarding the polydispersity index expressed in the present claims, the examiner is of the position that it would have been obvious and fully within the knowledge of one having ordinary skill in the art to control the optimum molecular weight, polydispersity, polymer composition and architectures of the resultant block copolymer product by varying experimental parameters such as source, amount, and solvation of catalyst/initiators/control agents, polymerization temperature and time, etc.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues the functional properties, such as dampening power, are not disclosed and the claimed combination of monomers. The examiner respectfully disagrees. The reference discloses block polymers which may comprise the specific monomers as the instant claims recite. Applicant's attention is directed to MPEP 2123, which discusses "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. While Galleguillos does not exemplify the specific combination, the components are disclosed. And therefore, one of ordinary skill in the art would be able to envision such a combination.

Regarding the functional properties, since Galleguillos similar compositions for the same purpose, therefore, it would have been obvious to one of ordinary skill in the art to have selected suitable monomers with the expectation of success in forming block polymers able to control the optimum molecular weight, polydispersity, polymer composition and architectures of the resultant polymer by routine experimentation, barring a showing to the contrary. The USPTO does not possess laboratory facilities, therefore, the examiner is unable to determine whether the functional properties would or would not be present in the cited prior arts composition. Burden shifts to Applicant to provide evidence of unexpected results.

Conclusion

Due to the new grounds of rejection presented in this office action, this action is made Non-Final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615